

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/119,209	07/20/98	LASKY	L 565D1C3

HM12/0426

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EXAMINER

PAK, M

ART UNIT	PAPER NUMBER
1646	5

DATE MAILED: 04/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/119,209

Applicant(s)

Laskey et al.

Examiner

Michael Pak

Group Art Unit

1646



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 49-56 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 49-56 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

#### **DETAILED ACTION**

1. Preliminary amendment filed 20 July 1998 (Paper NO. 2) has been entered.

2. The Preliminary amendment filed 20 July 1998 (Paper NO. 2) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows.

The incorporation by reference of parent application is objected to as introducing new matter into the specification.

Applicant is required to cancel the new matter in the response to this Office action.

#### ***Double Patenting***

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to

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be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 49-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,216,131. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-16 of the issued U.S. Patent No. 5,216,131.

The terminal disclaimer filed by the applicant in the parent application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

4. Claims 49-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,840,844. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to claims 1-13 of the issued U.S. Patent No. 5,840,844.

The terminal disclaimer filed by the applicant in the parent

application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

5. Claims 49-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 5,098,833. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 49-56 of the present application is generic to It would be obvious to one of ordinary skill in the art to use the process of claims 16-20 and the DNA and vector of claims 1-15 and 21-32 of the issued U.S. Patent No.5,840,844 to isolate the LHR protein of the claims 49-56 of the present application.

The terminal disclaimer filed by the applicant in the parent application 08/513,278 cannot be used for the present application because the terminal disclaimer only refers to the parent application.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 49-51 and 54-56 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

Woodruff et al. disclose the human lymphocyte homing receptor (pages 216-218)

The human lymphocyte homing receptor (hLHR) inherently has the same structure and sequence as the claimed sequence because the receptor was identified using the same technique as the mouse and rat and is isolated from the T-cells as are all other LHRs.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jalkanen et al. (IDS references 17-20) are cumulative reference with Woodruff et al. ((39); Ann. Rev. Immunol., 1987).

9. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

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Official papers filed by fax should be directed to (703) 308-4242.  
Faxed draft or informal communications with the examiner should be directed to  
(703) 308-0294.

Any inquiry of a general nature or relating to the status of this  
application or proceeding should be directed to the Group receptionist whose  
telephone number is (703) 308-0196.

*Michael D. Pak*  
Michael D. Pak  
Patent Examiner  
Art Unit 1646  
9 April 1999